REMARKS

This responds to the Office Action mailed on March 13, 2008.

Claim 1and 32 have been amended. Claims 1- 32 are pending in this application.

§102 Rejection of the Claims

Claims 1-3, 9-14, 19-24 and 29-32 were rejected under 35 U.S.C. § 102(e) for anticipation by Dettinger et al. (U.S. Patent No. 6,947,928, hereinafter "Dettinger"). To anticipate a claim, the reference must teach every element of the claim[1]. Applicants respectfully submit that the Office Action did not make out a *prima facie* case of anticipation[2] for at least the following reasons:

On page 3 of the Office Action, the Examiner cited Dettinger as disclosing "presenting an option to the user through the search interface to selectively include and exclude each of the first and second search criteria from a search query while retaining the first and second criteria within the search interface, the search query capable of being run against a database." Applicants respectfully disagree.

Dettinger generally relates to a graphical user interface for building queries with hierarchical conditions. See Col 2 lines 40-52. The Examiner states "Dettinger expressly show presenting the user an option (See edit, delete and/or, not) to include or exclude the birthdate and gender from the search query and maintains the criteria in the interface 520" and also cites Figures 4-6 and 9-17 for further support. Nowhere in the portions cited or anywhere in Dettinger is there any reference to "and **exclude** each of the first and second search criteria **from a search query** while **retaining** the first and second criteria **within the search interface**" (emphasis

[1] "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).* It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

[2] "[T]he exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference." *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 USPQ 781, 789 (Fed Cir. 1983). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

added). The Actions of Edit and Delete modify the search conditions of the search and thus would not "exclude.. search criteria from a search query while retaining the… criteria within the search interface." While the "And/Or 502" and "NOT 504" from Figure 5 may appear to include or exclude search conditions from a search query result, however they would still be included as part of a search query thus not satisfying the limitation of "exclude… search criteria from a search query." For example, in Dettinger a search may contain (Date of Birth <= 1942/01/01) AND (gender = male) NOT (hemoglobin <=5) and thus hemoglobin <= 5 may be excluded from the results found, but it is still included in the search query as it is a condition. The delete option would not retain any condition within the search interface and the edit option would only change the search condition.

Thus, Dettinger fails to disclose "presenting an option to the user through the search interface to selectively include and **exclude** each of the first and second search criteria **from a search query while retaining** the first and second criteria **within the search interface**, the search query capable of being run against a database" (Emphasis Added).

Applicants submits that, at least for these reasons, the 102(e) rejection has been overcome and the independent claim 1 and its corresponding dependent claims 2-3, 9-11 are patentable over Dettinger.

Independent claims 12, 22, and 32 and their dependent claims 13-14, 19-21, 23-24, and 29-31 include the same limitations as claim 1 above and thus are patentable and in the condition for allowance for at least the same reasons as claim 1 above.

§103 Rejection of the Claims

Claims 4-8, 15-18 and 25-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dettinger in view of Monahan et al. (U.S. Patent No. 6,523,037, hereinafter "Monahan").

Applicants submit that a dependent claims incorporate each of the claim elements of the independent claim from which it properly depends, and more. Applicants assert for the reasons stated in the prior section, that Dettinger does not teach or suggest all of the claim elements of the pending claims and the Office Action's proposed combination with Monahan does not cure

the defect. Therefore, Applicants respectfully request withdrawal of the 103(a) rejection and allowance of pending claims.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 636-681-1324 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 08/13/08

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 13th day of August 2008.

Dawn R. Shaw

Name

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Signature